



PTO/SB/33 (07-05)

United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 58268.00132
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/076,367 Filed: February 19, 2002
	First Named Inventor: Dennis S. LEE
	Art Unit: 2616
	Examiner: Donald L. Mills

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

- ☒ Attorney or agent of record.
Registration No. 58,178

- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Peter Flanagan
Signature

Peter Flanagan
Typed or printed name

703-720-7864
Telephone number

January 5, 2007
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 1505

Dennis S. LEE et al.

Art Unit: 2616

Application No.: 10/076,367

Examiner: Donald L. Mills

Filed: February 19, 2002

Attorney Dkt. No.: 58268.00132

For: METHOD AND APPARATUS FOR FLEXIBLE FRAME PROCESSING AND
CLASSIFICATION ENGINE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

January 5, 2007

Dear Commissioner of Patents:

Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-46 in the above identified application, in accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005, Official Gazette Notice. Claims 1-46 were finally rejected in an Office Action dated October 5, 2006 ("the Office Action"). Applicants filed a Response to the Final Office Action on October 30, 2006 ("the Response"), and the Office issued an Advisory Action dated November 28, 2006, maintaining the final rejections of claims 1-46. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Clear Error 1: Finality of the Office Action

The Office Action was improperly designated as Final, because the rejection was a non-necessitated new rejection. The original rejection was under 35 U.S.C. 102(b) and the new rejection was under 35 U.S.C. 102(e). The Advisory Action asserted that this was not a new rejection, because the original rejection simply included a typographical error. Applicants respectfully submit that the error was not simply a misspelling of 35 U.S.C. 102(b) for 35 U.S.C. 102(e).

As can be seen in the Non-Final Office Action mailed June 22, 2006, both the statement of the rejection in item 4, and the statute section quoted in item 3 are 35 U.S.C. 102(b). There is

no mention of sub-section 102(e). It was, therefore, clearly not simply a misspelling of 35 U.S.C. 102(e) (the new rejection) as 102(b) (the old rejection). This was a substantive error, as the cited reference is not available at all as prior art under subsection 102(b). When, as here, the rejection is a new rejection, and the new rejection is not necessitated by Applicants' amendments, it is not proper for the rejection to be designated "Final." At a minimum, therefore, reversal of the finality of the rejection is respectfully requested, which should permit Applicants to provide further amendments to the claims, provide additional evidence, or otherwise further prosecution in ways that are not available after a Final rejection. Applicants have a right to the rejection being designated as Non-Final, and it is unfair for the USPTO to place the burden for the USPTO's error (whether or not it was a typographical error) on Applicants.

Clear Error 2: Kadambi, clearly does not even mention certain elements of the claims.

A. Kadambi clearly does not even mention the recited "rule field includes a mask."

Each of the independent claims recites, "each rule field of said rules includes a mask and a selection flag used" for comparison of "said portion with each rule." Kadambi has no corresponding disclosure. Specifically, Kadambi does not disclose that any rule field of any rule includes a mask.

The Office Action asserted that Kadambi's "key" is a mask. However, Kadambi does not call its "key" a mask, and its key does not function as a mask. The Office Action does not provide any evidence or argument to support the Office Action's position that Kadambi's "key" is a mask. A rejection unsupported by evidence and argument is a rejection that must be reversed.

The Office Action's "Response to Arguments" section and the Advisory Action's continuation page contain several points:

1) "The claims are given a broad, reasonable, and literal interpretation. Limitations from the specification are not read into the claims, instead, the claims are read in light of the specification." This is a correct statement of the rule that must be applied. It is not an argument, however, that supports the rejection. The issue is whether Kadambi's "key" is a "mask" The answer to that issue is that Kadambi's key is not a mask. It is not called a mask, and it does not function as a mask. The issue is not a claim construction issue.

2) The Office Action observes that Kadambi teaches a “key” (among other things) and places the word “mask” in parentheses next to the word “key.” This argument, of course, totally fails to address the issue of whether the “key” is, in fact, a “mask.” The answer to that issue is that Kadambi’s key is not a mask. It is not called a mask, and it does not function as a mask. Thus, the Office Action’s statements are simply an incorrect assertion that the “key” is the claimed “mask,” and not either evidence or argument of such a correspondence.

3) “Also, in response to applicants’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., mask, selection flag) are not recited in the rejected claim(s).” This statement is clearly false. Below is a reproduction of the final two lines of claim 1, showing that both “mask” and “selection flag” are recited (note that the line number of the page and a portion of the USPTO’s stamp are included on the left side of the reproduction):

10 wherein each rule field of said rules includes a mask and a selection flag used
in the comparing said portion with each rule.

The recitations “mask” and “selection flag” are clearly present in the claim. Accordingly, the Advisory Action’s correct statement of law that “Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims,” (citation omitted) is irrelevant.

4) The Office Action stated “The generated key ... is a result of the application of the mask-portion of the filter to a field, and therefore, logically equivalent to a mask.” However, this statement is clearly incorrect. The fact that something is generated as the result of the application of a mask-portion of a filter to a field tends to distinguish it from a mask. Applicants understand that this argument has been withdrawn, as it was not repeated on the continuation sheet of the Advisory Action. It is addressed here simply for the sake of completeness.

5) Finally, the Office Action and Advisory Action suggested “If the Applicant wishes the claims to reflect a specific meaning, the claims should be amended to reflect such an intention or the Applicant should underscore the intended meanings from the disclosure. No specific meaning will be given to the claims, unless otherwise stated by the Applicant since claims are given the broadest literal reasonable interpretation.” Applicants respectfully submit that Applicants are entitled to have the claim terms given their ordinary meaning. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir.

1999)(“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”).” The Office Action’s refusal to give the words in the present patent claims their ordinary meaning (instead assigning them “no specific meaning”) is clearly contrary both to binding Federal Circuit precedent and the USPTO’s own regulations.

Specifically, 37 CFR 1.56(b) states that “A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.” “No specific meaning,” as asserted by the Office Action cannot possibly be the “broadest reasonable construction consistent with the specification.”

Likewise, the MPEP undermines the Office Action’s attempt to attach “no specific meaning” to the claim recitations. MPEP 2111 states, “The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).” “No specific meaning” cannot possibly be the interpretation that those skilled in the art would reach.

Indeed, the MPEP specifically states, at MPEP 2111.01: “THE WORDS OF A CLAIM MUST BE GIVEN THEIR “PLAIN MEANING” UNLESS SUCH MEANING IS INCONSISTENT WITH THE SPECIFICATION.” (Capital letters in original.). “No specific meaning” cannot possibly be the plain meaning of the claim terms.

Furthermore, MPEP 2111.01 also states: “ “PLAIN MEANING” REFERS TO THE ORDINARY AND CUSTOMARY MEANING GIVEN TO THE TERM BY THOSE OF ORDINARY SKILL IN THE ART.” (Capital letters in original). “No specific meaning” cannot possibly be the meaning given to the terms “mask” and “selection flag” by one of ordinary skill in the art. Therefore, for each of the reasons explained above, it is respectfully submitted that the Office Action’s position that Kadambi discloses the recited “rule field includes a mask” constitutes clear error, and the rejections of each of claims 1-46 should be reversed.

B. Kadambi clearly does not even mention the recited “rule field includes ... a selection flag.”


Each of the independent claims recites, “each rule field of said rules includes a mask and a selection flag used” for comparison of “said portion with each rule.” Kadambi has no corresponding disclosure. Specifically, Kadambi does not disclose that any rule field of any rule includes a selection flag.

The Office Action asserted that Kadambi’s “filter select” is a selection flag. However, Kadambi does not call its “filter select” a selection flag, and its filter select does not function as a selection flag. The Office Action does not provide any evidence or argument to support the Office Action’s position that Kadambi’s “filter select” is a “selection flag.” A rejection unsupported by evidence and argument is a rejection that must be reversed.

As noted above, the Response to Arguments section contains several points, each of which is addressed above with regard to the recited “mask.” As with the “mask” feature, the rejection fails to provide any argument or evidence showing that the “filter select” is a “selection flag,” as claimed. Thus, for this additional reason the rejection of each of claims 1-46 should be withdrawn.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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